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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,824	07/30/2003	Nareak Douk	P1354	7296
28390 7590 09/24/2007 MEDTRONIC VASCULAR, INC. IP LEGAL DEPARTMENT 3576 UNOCAL PLACE SANTA ROSA, CA 95403			EXAMINER KOHARSKI, CHRISTOPHER	
			ART UNIT 3763	PAPER NUMBER
			NOTIFICATION DATE 09/24/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rs.vasciplegal@medtronic.com

Office Action Summary

Application No.

10/629,824

Applicant(s)

DOUK, NAREAK

Examiner

Christopher D. Koharski

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 7-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 and 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Examiner acknowledges the reply filed 3/09/2007 in which claim 1 was amended. Applicant's Representative asserts that the amendment is merely clarification, however Examiner asserts that the "clarification" contains a change in scope of the claim, by Applicant amending the claim to spatially locate the proximal aspiration port from the "catheter end" (near 414) to the "aspiration shaft end" (401) (wherein the catheter and the aspiration shaft as defined as different elements) the claimed device has changed. Currently claims 1-14 are pending for examination, with claims 3 and 7-14 withdrawn from a previous election restriction.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Farrell (4,895,564). Farrell discloses a percutaneous femoral bypass system.

Regarding claim 1, Farrell discloses a catheter capable of aspiration comprising: a long continuous shaft capable of aspiration (16) (Figure 1A) having a fixed length and a lumen (Figure 3) extending between a distal aspiration port (14) disposed at a distal tip of said aspiration catheter (Figure 2A) and a proximal aspiration port (near 20, Figure 3) disposed at a proximal end of said aspiration shaft (16), said proximal aspiration port

capable of being adapted to be joined to a source of negative pressure; a proximal tube (19) and distal tube (18) having a first lumen and second lumen (Figure 2C) in which the aspiration lumen (16) is slidably located within each lumen, and the second lumen is within the first lumen, and said aspiration is fixed within the second lumen (Figure 2C).

Claim Rejections - 35 USC § 102

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Dubach et al. (5,788,713). Dubach et al. discloses a method and apparatus for stereotactic implantation.

Regarding claim 1, Dubach et al. discloses a catheter assembly capable of aspiration comprising: a long continuous shaft capable of aspiration (54) (Figures 2A-2E) having a fixed length and a lumen extending between a distal aspiration port (distal end of 54) disposed at a distal tip of said aspiration catheter (Figure 2A) and a proximal aspiration port (near proximal end of 54) disposed at a proximal end of said aspiration shaft (54), said proximal aspiration port capable of being adapted to be joined to a source of negative pressure; a proximal tube (52) and distal tube (56) having a first lumen and second lumen (Figures 2A-2E) in which the aspiration lumen (16) is slidably located within each lumen, and the second lumen is within the first lumen, and said aspiration is fixed within the second lumen by multiple guidance plates (42, 44, 46, 48) (Figures 2A-2E).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2 and 4-5 are rejected under 35 U.S.C 103(a) as being unpatentable over Farrell in view of Bagaoisan et al. (6,152,909). Farrell meets the claim limitations as described above except for the oblique distal port angle and distal adjacent guidewire port shaft.

However, Bagaoisan et al. teaches an aspiration system and method.

Regarding claims 2 and 4-5, Bagaosian et al. teaches an aspiration catheter (32) with a continuous fixed length shaft (36) with an oblique angle distal port (44) and attached guidewire lumen (40) at a distal end segment thereof (Figures 5-7B).

At the time of the invention, it would have been obvious to add the oblique angle distal port and guidewire shaft assembly of Bagaosian et al. to the system of Farrell in order to aid in insertion with the beveled tip and to allow for a separate guidewire shaft in order to allow for better unobstructed aspiration flow (col 9). The references are analogous in the art (catheter lumen intervention) and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have

combined the teachings in the references in light of the disclosure of Bagaosian et al. (cols 1-4, col 9).

Claim Rejections - 35 USC § 103

Claim 6 is rejected under 35 U.S.C 103(a) as being unpatentable over Farrell in view of (5,234,429). Farrell meets the claim limitations as described above except for the specific fixed stops attached to the proximal and distal tubes.

However, Goldhaber teaches a surgical telescoping cauterization instrument.

Regarding claim 6, Goldhaber teaches a telescoping assembly comprising multiple tube sections (34, 36, 40) in which there are several internal and external stops fixed to the inner and outer surfaces of the different elongation tube sections (see Figures 3-4).

At the time of the invention, it would have been obvious to add the stops of Goldhaber to the system of Farrell in order to add a sealing stop member to provide an exact fixed distance for each tube. The references are analogous in the art (telescoping surgical intervention devices) and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Goldhaber (cols 1-2).

Response to Arguments

Applicant's arguments with respect to claims 1-2 and 4-6 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on 7:30am to 4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date:

9/17/07

cdk

Christopher D. Koharski
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